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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,069	02/04/2000	Ted Eugene Wright	77017.002	9708
7590 06/04/2004				
ROBERT BERGSTROM BLACK LOWE & GRAHAM PLLC 816 SECOND AVENUE SEATTLE, WA 98104		EXAMINER CARTER, MONICA SMITH		
		ART UNIT 3722 PAPER NUMBER		

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/499,069	<b>Applicant(s)</b> WRIGHT, TED EUGENE	
	<b>Examiner</b> Monica S. Carter	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on March 11, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson ('119) in view of Skelton ('611).

Thompson discloses a ticket envelope (10) comprising a registration form (26); an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), the unfolded packet including at most two score lines (30 and 36) that

allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps (wherein the first step would be along score 30 and the second step would be along score 36); and a die-cut slot (42) in the unfolded packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like – see col. 3, lines 2-8; inherently, this would include keys).

Regarding the packet being a “key” packet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is capable of performing the intended use of being a key packet.

Thompson discloses the claimed invention except for the score lines being lines of perforations.

Skelton discloses a foldable envelope for tickets having a plurality of panels 24, 26, 28, 30, 32, 34, 36, 38, 40) separated from each other along adjoining edges by a perforated, embossed, or scored line “so that the panels might be folded, one over the other, and, for purposes later described, may be severed and separated, one from the other, along the perforated or embossed line” (see col. 2, lines 53-61). Skelton shows that scores and perforations are equivalent structures known in the art. Therefore, because these two creasing methods were art-recognized equivalents at the time the

invention was made, one of ordinary skill in the art would have found it obvious to substitute lines of perforations for the score lines in Thompson.

Regarding claims 2-4, Thompson, as modified by Skelton, discloses the panels being pre-printed with textual and graphical information (as seen in col. 4, lines 53-56 of Skelton – “may be printed with advertisement materials....printed display symbols and the like”). Note, it is inherently known that the printing would be generated by a conventional printing device.

Regarding claim 5, Thompson, as modified by Skelton, discloses the form and packet being rectangular and, when in the fully folded state, has a greater vertical dimension than a horizontal dimension (as seen in figure 1 of Thompson). Thompson, as modified by Skelton, further discloses that the registration form comprises the top portion of the registration form and packet and the registration form is separated from the unfolded packet by a horizontal line of perforations (viewing the envelope in figure 1 at a ninety degree angle would provide the horizontal line of perforations separating the top portion having the form from the bottom portion having the packet).

Regarding claim 7, Thompson, as modified by Skelton, discloses including a number of items in the packet (see col. 3, lines 2-8); this would, inherently, include keys consisting of metal keys and magnetic keys. It is further noted that the keys do not structurally limit the registration form and packet.

4. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Skelton and further in view of Crowell ('573).

Regarding claims 11 and 16, Thompson discloses a ticket envelope (10) comprising a registration form (26); an unfolded packet (combination of 22 and 24) separated from the registration form by a score line (40), the unfolded packet including at most score lines (30 and 36) that allow unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps (wherein the first step would be along score line 30 and the second step would be along score line 36); and a die-cut slot (42) in the unfolded packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like - see col. 3, lines 2-8; inherently, this would include keys).

Regarding the packet being a "key" packet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is capable of performing the intended use of being a key packet.

Thompson discloses the claimed invention except for the score lines being lines of perforations.

Skelton discloses a foldable envelope for tickets having a plurality of panels 24, 26, 28, 30, 32, 34, 36, 38, 40) separated from each other along adjoining edges by a perforated, embossed, or scored line "so that the panels might be folded, one over the

other, and, for purposes later described, may be severed and separated, one from the other, along the perforated or embossed line" (see col. 2, lines 53-61). Skelton shows that scores and perforations are equivalent structures known in the art. Therefore, because these two creasing methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute lines of perforations for the score lines in Thompson.

Thompson, as modified by Skelton, discloses the claimed invention except for explicitly disclosing the registration form and packet being printed on a printing device (commercially available computer laser printer).

Crowell discloses a foldable sheet (30) that can be printed on by a computer printer (to, inherently, include laser printers) (see col. 2, lines 45-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thompson's invention to include pre-printing information on the envelope by way of a computer printer, as taught by Crowell, to provide the envelope with advertising indicia and other related information to convey information to the user of the envelope.

Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the packet of Thompson is

capable of performing the intended use of being fed through a commercially available computer printer.

Regarding claims 12 and 17, Thompson, as modified by Skelton and Crowell, discloses the registration form and packet being made of any suitable paper stock (see col. 1, lines 63-66 of Thompson).

Regarding claims 13-15 and 18-20, Thompson, as modified by Skelton and Crowell, discloses the panels being pre-printed with textual and graphical information (as seen in col. 4, lines 53-56 of Skelton – “may be printed with advertisement materials....printed display symbols and the like”). Note, it is inherently known that the printing would be generated by a conventional printing device.

Regarding claim 21, Thompson, as modified by Skelton and Crowell, discloses the single sheet being rectangular (as seen in figure 1 of Thompson).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the examiner has failed to substantively consider or respond to the previous declaration. The examiner disagrees and asserts that the declaration was reviewed and addressed in the previous Office action mailed October 6, 2003. Furthermore, the examiner continues to maintain that the declaration is insufficient to overcome the rejections as set forth above.



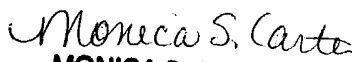
**Conclusion**


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 27, 2004

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**

  
**A. L. WELLINGTON**  
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